

REMARKS

INTRODUCTION

In accordance with the following, withdrawal of the finality of the outstanding Office Action, and issuance of a new Office Action consistent with the pending claims is respectfully requested.

Claims 1, 2, 6-8, and 10-26 are pending, with claims 1, 2, 6-8, and 10-19 being under consideration.

REQUEST FOR WITHDRAWAL OF FINALITY

Lack of Hot Pressure Welding Feature

The outstanding Office Action has repeated nearly verbatim the previous Office Action, while applicants had previously amended a hot pressure welding feature into independent claim 1, with the same already being present in claim 9 that was incorporated into claim 14.

Applicants had pointed out that the relied upon references failed to disclose the claimed hot pressure welding, but the Office Action has not addressed the same.

It is noted that "[a]nticipation requires the presence in a single prior art reference the disclosure of each and every element of the claimed invention, arranged as in the claim.

Lindemann Maschinenfabrik GMBH v. American Hoise and Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984). The Patent Office has the burden of making out a *prima facie* case, which requires it to produce the factual basis for its rejection in an application under §§102 and 103. In re Warner, 154 USPQ 173, 177 (CCPA 1967).

Again, it is noted that the relied upon references fail to disclose the claimed hot pressure welding feature.

The Office Action has apparently relied upon alternative "hot pressure welding or soldering" language, i.e., only one of the hot pressure welding or soldering would have to be disclosed to meet the anticipation requirement. The present application has provided at least two embodiments, one with hot pressure welding or soldering.

However, the claims do not set forth the claimed hot pressure welding in the alternative. Therefore, an anticipation rejection of claim 1 is improper.

New Rejection of Claim 1 not necessitated by Amendment

As noted above, the Office Action has repeated the previous § 102 rejection of claim 1, while the previous Office Action set forth that claim 1 (using Patil et al., U.S. Patent No. 6,425,655, as an example) failed to disclose the dependent features of hot pressure welding. Similarly, the other references relied upon to reject claim 1 under § 102 similarly failed to disclose this hot pressure welding.

However, the outstanding Office Action has again presented a § 102 rejection of claim 1, which is completely counter to the previous Office Action.

The Examiner has apparently changed the underlying interpretations of the relied upon references.

Further, as the claimed hot pressure welding feature was already in the dependent claims, the aforementioned amendment to claim 1 did not change the scope of claim 1, nor require an additional search.

Thus, the outstanding Office Action's new rejection of claim 1 is improper for a Final Office Action.

REJECTIONS UNDER 35 USC 102

Claim 1 stands rejected under 35 U.S.C. 102(b) as being anticipated by Komuro et al., U.S. Patent No. 4,873,622, claim 1 stands rejected under 35 U.S.C. 102(e) as being anticipated by Patil et al., U.S. Patent No. 6,425,655, and claim 1 stands rejected under 35 U.S.C. 102(e) as being anticipated by Akhavain et al., U.S. Patent No. 6,543,880.

As noted above, the relied upon references fail to disclose the claimed hot pressure welding. Withdrawal of this rejection is respectfully requested.

REJECTIONS UNDER 35 USC 103

Claims 2, 6-8, and 10-19 stand rejected under 35 U.S.C. 103(a) as being obvious over Patil et al., in view of Asano, U.S. Patent No. 6,396,665. This rejection is respectfully traversed.

As set forth in Applicants' previous response, it is respectfully submitted that there is no evidence in the record that there would have been any motivation for the suggested modification of Patil et al. In particular, it is respectfully submitted that the Office Action has merely set forth features Asano and set forth that the addition of the same into Patil et al. would have been obvious so Patil et al. would include such features, without support in the record.

Applicants further noted that that none of the cited references provide any support or evidence that there would be a need or desire to modify Patil et al. as suggested. In addition, nothing in the record provides any evidence or suggestion that Patil et al. needs or desires the suggested "reinforcing the connection strength through the connecting end portions and the FBC."

Applicants thereafter provided the Examiner with the MPEP and Federal Circuit requirements for a *prima facie* obviousness case.

With regard to the Federal Circuit precedent, "it is well established that agencies have a duty to provide reviewing courts with a sufficient explanation for their decisions so that those decisions may be judged against the relevant statutory standards, and that failure to provide such an explanation is grounds for striking down the action," in addition, "an agency is not free to refuse to follow circuit precedent." In re Lee 61 USPQ2d 1430, 1434 (CA FC 2002).

Thus, the previous noted precedent still is binding in the present case.

In response to this traversal, the Office Action has merely set forth a boiler plate response to obviousness rejections, with a brief repetition of the obviousness rejection presented in the § 103 rejection.

Again, the Office Action has stated that "[s]ince welding or soldering suggested by Asano would [reinforce] the connection strength through the connecting end positions and the FBC, incorporating the suggestions of Asano in the device of Patil et al. would have been obvious to a person having skill in the art at the time the invention was made.

However, this is the underlying motivation relied upon by the Office Action, i.e., that because Asano has benefited in some manner from soldering then the same benefit would be desirable in Patil et al.

However, this is improper motivation. The mere fact that a feature provides a benefit to the corresponding underlying system does not automatically mean that the same feature would be beneficial to a second reference, combinable with the second reference, or even desirable in the second reference.

The relied upon motivation fails to provide any link between the benefit in Asano and Patil et al., i.e., there is no discussion as to whether Patil et al. would suffer from any problem necessitating such a modification. The mere modification for improvement is improper.

The mere fact that the prior art may be modified in the manner suggested in the Office Action does not make the modification obvious unless the prior art suggested the desirability of

the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

Again, the following is further noted:

MPEP § 2142 states that "it is the duty of the Examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617.

The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

Further, it is well settled that "the Board [and Examiner] cannot simply reach conclusions based on [their] own understanding or experience - or on [their] assessment of what would be basic knowledge or common sense. Rather the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F. 3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of "common knowledge" and "common sense" may only be applied to the analysis of evidence, rather than be a substitute for evidence.

Thus, accordingly, a prima facie obviousness rejection requires evidenced motivation from something in the record that would lead one skilled in the art to combine the relevant teachings. The mere fact that the prior art may be modified in a particular manner does not make the modification obvious unless the prior art suggested the desirability of that modification.

Accordingly, it is respectfully submitted that the outstanding motivation is improper.

Rather, as noted previously, it is respectfully submitted that the present invention has a particular orientation of the connector, and particularly explains how the connector can connect to each of the pad or bonding portions. In particular, the notch implemented by the present invention created by the claimed opening permits the use of the claimed hot pressure welding.

Conversely, none of the cited references, including Patil et al., have an orientation susceptible for such the claimed "wherein a connection member is bonded to a corresponding pad of the substrate and/or a corresponding bonding portion of the FPC by hot pressure welding"

Thus, it is respectfully submitted that it would not have been obvious to modify Patil et al. to disclose the presently claimed invention.

Therefore, for at least the above, it is respectfully requested that the outstanding rejections be withdrawn and the presently claimed invention be allowed.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

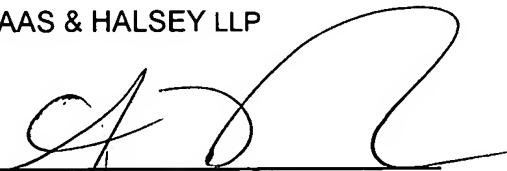
If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: 12/25/05

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